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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/774,614	02/01/2001	Masayuki Inagaki	Q62932	3351

7590 09/24/2004

SUGHRUE, MION, ZINN, MACPEAK & SEAS
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037-3202

EXAMINER

HOFFMAN, BRANDON S

ART UNIT	PAPER NUMBER
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2136

DATE MAILED: 09/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/774,614	Applicant(s) INAGAKI ET AL.	
	Examiner Brandon Hoffman	Art Unit 2136	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 February 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>20040916</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 2, 5-7, and 10-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Clark et al. (U.S. Patent No. 6,442,588).

Regarding claim 1, Clark et al. teaches an information provision control system which when accessed via the Internet, provides as a response information stored on a contents server, comprising:

- An authentication domain name storage device which stores domain names or IP addresses of terminals belonging to an affiliated party who is permitted to obtain the information stored on said contents server (col. 4, lines 59-64);

- An authentication domain name judgment device which examines domain name or IP address of a terminal which has gained access, compares said domain name or said IP address with said domain name or said IP address of the terminal of said affiliated party which is stored in said authentication domain name storage device, and judges if said terminal is the terminal of said affiliated party (col. 7, lines 13-19 and fig. 6A); and
- A member management server which, in the case where said terminal is the terminal of said affiliated party, limits the range of information to be provided according to said affiliated party (col. 7, lines 19-22).

Regarding claim 6, Clark et al. teaches an information provision control system which when accessed via the Internet, provides as a response information stored on a contents server, comprising:

- An authentication identification number storage device which stores identification numbers which members who are permitted to obtain the information stored in said contents server have (col. 4, lines 30-44);
- An authentication identification number judgment device which examines identification number which is input at the time of provider connection or at the time of connection to contents server, compares said identification number with said identification numbers of said member stored in said authentication identification number storage device, and judging if the person who accessed said contents server is one of said members (col. 6, lines 17-43 and fig. 4A); and

- A member management server which, in the case where the person who has gained access is a member, limits the range of information to be provided according to said member (col. 7, lines 19-22).

Regarding claims 2 and 7, Clark et al. teaches further comprising an access control device which limits access to said contents server depending on connection time or connection environment (col. 7, lines 64-67).

Regarding claims 5 and 10, Clark et al. teaches further comprising:

- An information provision device which provides information to members (col. 1, lines 59-67); and
- An information management device which sets, according to said member, at least one of a right to refer to said information, a right to update said information, and a right to delete said information (col. 1, lines 59-67).

Regarding claim 11, Clark et al. teaches an information provision control method which at the time of access via the Internet, provides as a response information stored on a contents server, comprising:

- A first step of, when said information provision control system is accessed, examining a domain name or IP address of the terminal which has gained access, and judging if said terminal is a terminal belonging to an affiliated party (col. 7, lines 13-19 and fig. 6A); and

- A second step of, in the case where said terminal is the terminal belonging to said affiliated party, providing information decided according to said affiliated party (col. 7, lines 19-22).

Regarding claim 12, Clark et al. teaches an information provision control method which at the time of access via the Internet, provides as a response information stored on a contents server, comprising:

- A first step of, when said contents server is accessed, examining an identification number which is read at the time of provider connection or at the time of connection to said contents server, and judging if the person who accessed said contents server is one of members (col. 6, lines 17-43 and fig. 4A); and
- A second step of, in the case where the person who has gained access is one of said members, providing information decided according to said members (col. 7, lines 19-22).

Regarding claim 13, Clark et al. teaches a computer readable recording medium recorded with a program for at the time of access via the Internet, providing as a response information stored on a contents server, wherein said program executes on a computer:

- A function for storing domain names or IP addresses of terminals belonging to an affiliated party who is permitted to obtain the information stored on said contents server (col. 4, lines 59-64);

- A function for, when said contents server is accessed, comparing said domain name or said IP address of the terminal which has gained access, with said domain name or said IP address of the terminal of said affiliated party which is stored, and judging if said terminal is one of said terminals belonging to said affiliated party (col. 7, lines 13-19 and fig. 6A); and
- A function for, in the case where said terminal is one of said terminals belonging to said affiliated party, limiting the range of information to be provided according to said affiliated party (col. 7, lines 19-22).

Regarding claim 14, Clark et al. teaches a computer readable recording medium recorded with a program for at the time of access via the Internet, providing as a response information stored on a contents server, wherein said program executes on a computer:

- A function for storing identification numbers which members who are permitted to obtain the information stored in said contents server have (col. 4, lines 30-44);
- A function for when said contents server is accessed, comparing an identification number which is read in at the time of provider connection or at the time of said contents server connection, with said identification number of said members which are stored, and judging if the person who accessed said contents server is one of said members (col. 6, lines 17-43 and fig. 4A); and

- A function for, in the case where the person who has gained access is a member, limiting the range of information to be provided according to said member (col. 7, lines 19-22).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3, 4, 8, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clark et al. (USPN '456) in view of Nazem et al. (U.S. Patent No. 5,983,227).

Regarding claims 3 and 8, Clark et al. teaches all the limitations of claims 1 and 6, respectively, above. However, Clark et al. does not teach wherein said contents server further comprises a contents configuration components filing device which individually files frame data or text data or image file data constituting the contents; and a dynamic contents creation function device which creates contents wherein the frame data or the text data or the image file data filed by said contents configuration component filing device, is rearranged according to said member who has accessed said contents server.

Nazem et al. teaches wherein said contents server further comprises: ✓

- A contents configuration components filing device which individually files frame data or text data or image file data constituting the contents (fig. 2, ref. num 202); and
- A dynamic contents creation function device which creates contents wherein the frame data or the text data or the image file data filed by said contents configuration component filing device, is rearranged according to said member who has accessed said contents server (fig. 2, ref. num 210 and 218 and fig. 5).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine a configuration filing device and a dynamic content creation device, as taught by Nazem et al., with the system of Clark et al. It would have been obvious for such modifications because dynamic pages containing content for individuals, instead of the whole population, add appeal to the content (see col. 1, lines 19-29 of Nazem et al.).

Regarding claims 4 and 9, Clark et al. teaches all the limitations of claims 1 and 6, respectively, above. However, Clark et al. does not teach wherein said member management server further comprises a member retrieval device which retrieves members who satisfy conditions which have been input; and a mail transmission device which transmits E-mails to said members who have been retrieved by said member retrieval device.

Nazem et al. teaches wherein said member management server further comprises:

- A member retrieval device which retrieves members who satisfy conditions which have been input (col. 3, lines 15-21, a cookie is sent to retrieve a specific member); and
- A mail transmission device which transmits E-mails to said members who have been retrieved by said member retrieval device (official notice is taken that emailing the member would be similar to informing the member by other methods, such as retrieving a specific page for that user only).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine a member retrieval device and a mail transmission device, as taught by Nazem et al., with the system of Clark et al. It would have been obvious for such modifications because informing a member that they were the one retrieved using a certain set of credentials informs said member of a proper entry into the system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brandon Hoffman whose telephone number is 703-305-4662. The examiner can normally be reached on M-F 8:30 - 5:00. However, my new office number will be 571-272-3863 after our October move.

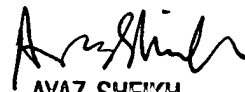
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 703-305-9648. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Branda Hef

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